

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ELLEN KARDY

Appeal No. 2001-1768
Application No. 09/285,787

ON BRIEF

Before COHEN, ABRAMS, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-8, 10, 11
and 14, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a storage cabinet. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Pichowicz	3,390,702	Jan. 6, 1976
LeSage	4,324,446	Apr. 13, 1982
Ellingsworth <u>et al.</u> (Ellingsworth)	5,242,048	Sep. 7, 1993
Ball (Canadian Patent)	494,936	Jul. 28, 1953

Claims 1-4, 7, 8 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over LeSage in view of Ellingsworth and Ball.

Claims 5, 6, 11 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over LeSage in view of Ellingsworth, Ball and Pichowicz.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 17) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 16) and Reply Brief (Paper No. 18) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

It is the examiner's view that LeSage discloses all of the subject matter set forth in independent claim 1 except for the plurality of transverse members arranged in the frames and having supporting means for supporting stored items, and the flexible sheet

separating means. However, it is the examiner's opinion that it would have been obvious to one of ordinary skill in the art to modify the LeSage cabinet by providing in each frame a plurality of transverse members with supporting means for holding the stored items, in view of the teachings of Ellingsworth, and to provide a flexible separation means in view of the showing of Ball. The essence of the appellant's arguments is that there would have been no suggestion to combine the teachings of the references in the manner proposed by the examiner and, even if such were proper, the result would not be the claimed structure.

Claim 1 requires that the separation means be "a flexible sheet for allowing the stored items in one of the . . . frames to intrude into the other" (emphasis added). The common definition of "flexible" is bendable, especially repeatedly.¹ It is in this context in which the appellant has disclosed the sheet in the specification and set it out in the claims and, in fact, has amplified it by explaining that it must be capable of functioning in such a manner as to allow the stored items in one frame to intrude into the space of the other.

Nevertheless, the examiner has taken the position that the PLEXIGLAS door panel disclosed by Ball is flexible (Answer, page 5) because this material is used as walls in hockey arenas and therefore "obviously must have some flexibility/give" (Answer, page 7). The examiner also notes that "the limitation directed to the intrusion of items . . . appears in an intended use statement" and therefore has been given no weight (Answer, page 5).

¹See, for example, Webster's New Collegiate Dictionary, 1973, page 439.

The examiner's reasoning is untenable on its face. There simply is no evidence supporting the examiner's opinion that PLEXIGLAS is "flexible" and, from our perspective, the analogy to the walls of a hockey arena undermines that opinion, rather than supporting it. Moreover, as is pointed out by the appellant in the Reply Brief, it is a structural requirement of the flexible sheet that it be flexible enough to allow the items in one frame to intrude into the space of the other frame. Therefore, even if one were to accept at face value the examiner's statement that PLEXIGLAS is flexible enough to be used as the wall in a hockey arena, it still would not meet the requirements of the claim that it allow the stored items in one frame to intrude into the other. Moreover, as the appellant also has argued in the Briefs, the examiner has provided no reason why one of ordinary skill in the art would have been motivated to modify the LeSage cabinet in such a manner as to meet the terms of the claim, that is, to replace the transparent panels (46) of LeSage with their soft resilient material (84) for holding the jewelry articles separated from one another with the claimed flexible sheet.

It is our conclusion that the combined teachings of LeSage, Ellingsworth and Ball fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and we therefore will not sustain the rejection of claim 1 or, it follows, of dependent claims 2-4, 7, 8 and 10, which stand rejected on the same basis.

Dependent claims 5, 6, 11 and 14 are rejected on the basis of the references applied against claim 1 et al. taken further in view of Pichowicz, which is cited for its teaching of providing a decorative cover over a wall cabinet member. Be that as it may, this additional reference does not cure the problems pointed out above with regard to the rejection of claim 1. This being the case, we also will not sustain the rejection of claims 5, 6, 11 and 14.

SUMMARY

Neither rejection is sustained.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER
1300 I STREET N W
WASHINGTON, DC 20005-3315